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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,478	02/07/2002	Chester Gary Nelson	P-8675.02	8288
27581	7590	09/29/2004	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604			EVANISKO, GEORGE ROBERT	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/068,478	NELSON ET AL.	
	Examiner	Art Unit	
	George R Evanisko	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-33 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/2/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-16, drawn to a PDM unit, classified in class 600, subclass 300.
- II. Claims 17-33, drawn to a method of remote delivery of therapy, diagnostics and monitoring, classified in class 607, subclass 59.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus not requiring a bar code scanner or flat panel display but using a keyboard to enter the bar code and using a display with a CRT.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dan Chapik on 9/20/04 a provisional election was made with traverse to prosecute the invention of group II, claims 17-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 3762

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 4, “and a PDM operating as web-compatible interface medical devices for an IMD support interactive software and hardware adapted to support...” is vague and not worded correctly. It is unclear what elements or steps are being claimed. In line 6, “the IMDs” lack antecedent basis. In line 6, “wherein a remote data center is in data communications, via a network link,...” is vague and does not state what element the data center is in communications with.

In claims 18-22 and 29-33, the claims are vague since they are in the passive voice. It is unclear if a structural limitation or a method step is being claimed. Method steps should be in the active voice to positively recite a method step. The examiner has considered the claims to be method steps and the claims should be amended to be in the active voice.

In claim 29, “, data packets routed” is vague and it is unclear what the data packets refer to. In addition, “the PDM’s high speed wireless network interface” lacks antecedent basis.

In claim 30, “the PDM’s serial port” lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-19, 22-24, 26, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Snell (6249705). Snell shows in figure 1 the remote data center (elements 102 and 103), the programmer (element 104_N) and the PDM (element 104₃) and shows the programmer and PDM connected to each other through the network (element 107 or element 126 in figure 2) and discusses the use of any programmer/PDM connected to another PDM/programmer to allow easy access to stored information (column 5, lines 26-30). It is noted that although element 104₃ is stated to be a programmer in the Snell reference, it still meets the limitations and is considered to be a personal data messenger since a physician can use it to transfer data between the remote data center, the IMD, and other programmers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3762

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20, 21, 25, 27, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snell. Snell shows in figure 2 the programmer/PDM connected through element 118 to a system with a display, keyboard, and mouse, but does not call the system a PC. In addition, Snell states in column 3 that the programmer/PDM can be connected to a printer but does not state that the PDM stores information.

Snell discloses the claimed invention except for the use of a satellite or GPS as the network (claims 25 and 27) or the PDM implemented to: store and forward data to a PC (claim 32); store and forward information to a printer (claim 33); secure identification of the IMD before implant (claim 20); and transfer pre-implant data to the programmer (claim 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the IMD communication and programmer system as taught by Snell, with a PDM implemented to: store and forward data to a PC (claim 32); store and forward information to a printer (claim 33); secure identification of the IMD before implant (claim 20); and transfer pre-

Art Unit: 3762

implant data to the programmer (claim 21), and use a satellite or GPS as the network since it was known in the art that IMD communication and programmer systems use a PDM implemented to: store and forward data to a PC (claim 32) to allow the physician to store data for later use and analysis by the physician; store and forward information to a printer (claim 33) to allow the physician to print out data for later use and analysis; secure identification of the IMD before implant (claim 20) to allow the PDM to program the proper IMD and/or to make sure the PDM is compatible with the IMD; and transfer pre-implant data to the programmer (claim 21) to set-up the IMD with the correct therapy parameters before it is used in the patient, and since it was known in the art that IMD communication and programmer systems use a satellite or GPS as the network to allow the communication of data over long distances over conventional and existing networked systems.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


George R Evanisko
Primary Examiner
Art Unit 3762

9/27/04

GRE
September 27, 2004